

REMARKS

Claims 19 to 21 are canceled without prejudice (*since they were forced to be elected by the Examiner in the Final Office Action; Applicants may pursue, as a matter of right, claims 19 top 21 in a divisional application*), and therefore claims 9 and 11 to 18 are now pending and being considered.

Reconsideration is respectfully requested based on the following.

It is respectfully requested that the Examiner acknowledge acceptance of the Drawings, especially since the Drawings were previously amended and since the Examiner no longer objects to the Drawings.

It is noted that claims 19 to 21 are canceled without prejudice, since they were forced to be elected by the Examiner in the Final Office Action. Applicants may, of course, pursue, as a matter of right, claims 19 top 21 in a divisional application.

Applicants thank the Examiner for allowing claims 15 and 16, and for indicating that claims 13 and 18 contain allowable subject matter. However, the present application has an effective U.S. National phase application filing date of January 18, 2005, and it therefore antedates the May 19, 2005 filing date of U.S. Patent Application Publication No. US 2006/0171579 (“Lee”). (It is noted that the present application also has a German priority date of March 25, 2004, but this date need not be established since the national phase filing date of January 18, 2005 is earlier than the May 19, 2005 filing date of the applied Lee reference). Since the rejections of the base claims are obviated, as explained herein, it is respectfully requested that the objections be withdrawn.

Claim 14 was rejected under the second paragraph of 35 U.S.C. § 112, as indefinite.

Claim 14 has been corrected as to the minor grammatical and antecedent issues, as suggested. It is therefore respectfully requested that the indefiniteness rejections be withdrawn.

Claims 9, 11, 12, and 17 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. US 2006/0171579 (“Lee”).

U.S. Patent Application No. 10/593,914
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Reply to Final Office Action of December 15, 2008

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As explained above, the present application has an effective U.S. National phase application filing date of January 18, 2005, and it therefore antedates the May 19, 2005 filing date of U.S. Patent Application Publication No. US 2006/0171579. (It is noted that the present application also has a German priority date of March 25, 2004, but this date need not be established since the national phase filing date of January 18, 2005 is earlier than the May 19, 2005 filing date of the applied Lee reference). It is therefore respectfully requested that the anticipation rejections be withdrawn.

Accordingly, claim 9, as presented, is allowable, as are its dependent claims 11, 12, and 17.

In sum, all of pending and considered claims 9, 11 to 14 and 17 are allowable – like allowed claims 15 and 16.

CONCLUSION

In view of the foregoing, pending and considered claims 9, 11 to 14 and 17 are allowable – like allowed claims 15 and 16. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,

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